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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/822,049
Filing Date: April 10, 2004
Appellant(s): ROSENBERGER, RONALD JOHN

Rosenberger
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-7-08 appealing from the Office action mailed 9-8-06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Claims 1-2, 4-10, 12-13 and 16-17 are rejected and are on appeal.

Claims 3, 11, 14-15 and 18-20 are canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The after final amendment filed 12-8-06 has not been entered.

The after final amendment filed 2-8-07 has not been entered.

Examiner agrees with appellant's statement that "... the claims stand for the present Appeal in the form they were amended and canceled in the Amendment and Response filed June 14, 2006 to the non-final Office Action of March 14, 2006". (page 3 of Brief filed 3-7-08).

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. Statements 1 and 3-8 on page 5 of the Brief filed 3-7-08 are correct statements of the grounds of rejection to be reviewed on appeal.

Appellant's brief presents arguments relating to the objection to claim 10 under 37 CFR 1.75(c). This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. In other words, statement 2 on page 5 of the Brief filed 3-7-08 is not a ground of rejection to be reviewed on appeal.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

GB 2,243,584	Great Britain 584	Nov. 6, 1991
KR 2004029611	Korea	April 8, 2004
JP 2002-114873	Japan 873	April 16, 2002
DE 2,949,356	German 356	June 11, 1981
FR 2,800,013	French 013	April 27, 2001
CA 547,958	Canada 958	Oct. 29, 1957
JP 11-151908	Japan 908	June 8, 1999
US 5,278,141	Berliner	Jan. 11, 1994

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FR 1,498,340

French 340

Sept. 11, 1967

WO 01/43958

Mellet et al

June 21, 2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the description of "said void, insert, o-ring or plug comprises ... a groove, channel or crevice" is confusing. It appears that only the void comprises a groove, channel or crevice". It appears that an o-ring comprising a groove provided in at least one void is not intended.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Great Britain 584

Claims 1, 4-10, 12-13 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain 584 (GB 2,243,584).

Great Britain 584 discloses a vehicle tire such as a car tire having grooves 21 and wear indicators 10 wherein the wear indicator 10 is a rubber, grommet, block or stud made from three layers of different colored rubber or alternatively two angled wedges. The wear indicator 10 is pushed into the groove such that the outer surface of the wear indicator is flush with the outer surface of the tread. The wear indicator 10 is held in the place by elasticity of the walls of the groove 21. See page 3.

As to claim 1, the claimed tire is anticipated by Great Britain 584's vehicle tire. The claimed removable insert, ring or plug reads on the wear indicator 10. This wear indicator is "removable" since it is held in the groove (void) merely by the elasticity of the walls of the groove. With respect to the insert, o-ring or insert comprising at least one scent or fragrance, Great Britain 584's rubber wear indicator, like all rubber, inherently has a "scent". It is noted that terms such as "novelty", "unique aroma" and "salient, distinctive, and marketable feature of said vehicle tire" were deleted from claim 1. Furthermore, Great Britain 584's rubber wear indicator wears at the same rate as the tread (page 2) such that lower regions of rubber, which also inherently have a "scent", are exposed.

As to claims 4 and 13 (wear warning component), note Great Britain 584's use of plural wear indicators.

As to claim 5 (color), Great Britain 584's wear indicator comprises different colored rubber layers. In view of the opposite terms "coordinated" and "incongruous", claim 5 fails to define a color different from that suggested by Great Britain 584.

As to claims 6 and 7 (void), Great Britain 584 locates the wear indicators 10 in grooves.

As to claim 8, Great Britain 584 discloses a car tire (page 3).

As to claim 9, Great Britain 584 shows two wear indicators 10 in the same groove
21. See figure 3.

As to claim 10 (removable), Great Britain 584's wear indicator is removable from the void since it is held in the groove merely by the elasticity of the groove.

As to claim 12 (e.g. reflective, fluorescent), Great Britain 584 teaches including reflective particles in the layers of the wear indicator or making the middle layer fluorescent.

As to claim 16 (wear indicator formed by pouring, pumping, injecting or spraying), this product by process claim fails to require structure different from the rubber wear indicator disclosed by Great Britain 584. See MPEP 2113.

As to claim 17, Great Britain 584's wear indicator comprises at least two "sections" such as three layers.

Claims 1, 4-10, 12-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 584 in view of Korea (2004029611), Japan 873 (JP 2002-114873) or German 356 (DE 2,949,356).

Korea (published 4-8-04 as evidenced by the Derwent abstract and page 1 of translation) is available as prior art since applicant is not entitled to the benefit of

the filing date 4-17-03 of applicant's provisional application. See MPEP 201.11. None of the pending claims is directed solely to the subject matter disclosed in the provisional application. For example, the provisional application does not support "at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire". Hence, Korea is available as prior art under 35 USC 102(a) because (1) its publication date (4-8-04) is before applicant's filing date (4-10-04) and (2) claims 1-2, 4-10, 12-13 and 16-17 are not entitled to the benefit of the filing date of applicant's provisional application 60/463,653. Claim 1 describes subject matter (e.g. removable insert, o-ring, or plug) not described in the provisional application.

Great Britain 584 is considered to anticipate claim 1. In any event: it would have been obvious to one of ordinary skill in the art to provide Great Britain 584's rubber wear indicator, which is part of the tread, such that it comprises a "scent" in view of one of Korea, Japan 873 and German 356 wherein Korea (directed to the tire art) teaches using a composition comprising rubber and aromatic material such that smell is generated from the tread when the tread reaches the wear limit (abstract, pages 5 and 6 of translation), Japan 873 (directed to the tire art) suggests including perfume sealed particles in a tread composition such that perfume is released by wear of the tread so as to emit a desired aroma for a long time (abstract, paragraph 10 of translation), and German 356 (directed to a wear monitor) suggests providing a wear monitor in a lining such that the indicator emits a smell when the lining has worn (abstract, pages 2 and 8 of translation).

Japan 873

Claims 1, 5-10 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 (JP 2002-114873) in view of French 013 (FR 2,800,013), Canada 958 (CA 547,958) or Japan 908 (JP 11-151908).

Japan 873 discloses a pneumatic tire for a passenger car having a size such as 185/65R14. One of ordinary skill in the art would readily appreciate from this description that such a tire is a pneumatic radial tire having a tread, sidewalls, radial carcass, belt and bead portions. The tread of this tire comprises particles containing perfume. Japan 873 teaches that the perfume containing particles are exposed with tread wear and that the aroma is emitted for a long time. See abstract and paragraph 10 of translation. Japan 873 does not recite the tire as having a removable insert.

As to claim 1, it would have been obvious to one of ordinary skill in the art to provide Japan 873's tire with a removable insert in a void such that the insert, which is part of the tread, comprises a "scent" which is released as the tire wears in view of (1) Japan 873's teaching to include perfume containing particles in a tread such that the perfume containing particles are exposed with tread wear and that the aroma is emitted for a long time and (2) the suggestion from French 013, Canada 958 or Japan 908 to provide a tire with an insert wherein French 013 teaches providing a removable colored auxiliary tire 20 ("removable insert") in a trough 11 of an outer annular tread such that the auxiliary tire 20 can be replaced with a different color (abstract, pages 2-4 of translation), Canada 958 teaches providing a tire with a removable tire component 7 ("removable insert") in a recess 4 so that the tread can be replaced when worn and thereby avoid the cost of replacing the entire tire (columns 2 and 3) and Japan 908 teaches providing a tire with colored member 6 ("removable inserts") in a groove of a tire tread to improve the fashionableness of the tire (abstract, paragraphs 3, 4, 13, 14 and 35 of translation). The term "insert" is generic to "o-ring". With respect to Japan

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908's insert being removable, see paragraphs 13, 14 and 35 of translation of Japan 908. In particular, Japan 908 teaches locating colored members 6 in grooves of a tire tread (either by inserting premanufactured rings in the grooves or pouring colored material in the grooves) to improve the fashionableness of the tire (abstract, paragraphs 3, 4, 13, 14 and 35 of translation). It is noted that (1) "removable" is a relative term, (2) claim 16 recites an insert formed by pouring and (3) page 18 of the specification teaches that the insert may be removed by using a drill or a dremel tool (cutting / grinding tool). Hence, one of ordinary skill in the art would have been motivated to include perfume containing particles in the removable insert of French 013, Canada 958 or Japan 908 so as to obtain the expected benefits of (1) a tread which can emit desired aroma as the tire wears and (2) having part of the tread being removable to change color of the tread (French 013), having part of the tread replaceable to avoid the cost of replacing the entire tread (Canada 958) or improving the fashionableness of the tire (Japan 908). It is emphasized that each of the "removable inserts" of French 013, Canada 958 and Japan 908 constitute part of the tread and Japan 873 suggests including perfume containing particles in the entire tire tread (all parts of the tread).

As to claim 5, French 013 and Japan 908 teach a colored insert. Also, the insert of Canada 958 must have a color (i.e. black).

As to claim 6 (void), French 013 teaches a trough 11, Canada 958 teaches a recess 4 and Japan 908 teaches a groove 7.

As to claims 7, 9, 16 and 17, Japan 908 teaches using plural colored members 6 two or more kinds of colors.

As to claim 8 (tire), note the type of tire suggests by the applied prior art. For example, Japan 873 teaches a car tire.

As to claim 10 (removable), French 013, Canada 958 and Japan 908's "insert" is "removable".

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 in view of French 013, Canada 958 or Japan 908 as applied above and further in view of Berliner (US 5,278,141).

As to claim 2, it would have been obvious to one of ordinary skill in the art to use both a perfume and a pheromone as the perfume in the tire of Japan 873 since Berliner suggests (1) using both perfumery odorant and a pheromone in a perfume to make the perfume more appealing and (2) using perfume in a variety of products (col. 7 lines 30-52).

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 in view of French 013, Canada 958 or Japan 908 as applied above and further in view of French 340 (FR 1,498,340).

As to claims 4 and 13, it would have been obvious to one of ordinary skill in the art to provide the perfume containing particle tire tread with the claimed wear warning component since French 340 suggests locating a colored indicator (e.g. colored rubber or tearable cell containing coloring agents) in the groove of a tire to achieve visual monitoring of the degree of wear of the tire (see pages 2-4 of translation).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 873 in view of French 013, Canada 958 or Japan 908 as applied above and further in view of Mellet et al (WO 01/43958).

As to claim 12, it would have been obvious to one of ordinary skill in the art to use reflective particles in the rubber tread insert since (1) French 013 or Japan 908 teach using a colored insert for a tire tread and (2) Mellet et al teaches providing a cover for a tire with color and reflective particles (page 6).

(10) Response to Argument

112 second paragraph

Appellant comments that he would be willing to amend the claims to remove the 112 second paragraph rejection. Since appellant has not provided specific reasons why the 112 second paragraph rejection should be reversed, the 112 second paragraph rejection of claims 6-9 and 16 stands.

Great Britain 584 / 102 rejection

Appellant argues that Great Britain 584 fails to teach an *added* scent or fragrance *compound* and directs attention to the disclosure which describes incorporating novelty scent or fragrance in rubber compound(s). This argument is not commensurate in scope with the claims and is therefore not persuasive since none of the claims require a composition comprising two compounds wherein one compound is a scent or fragrance compound and the other compound is a rubber compound(s).

With respect to Great Britain 584, appellant argues that the claimed plug or insert does not include "the use of scent as a tire wear indicator". This argument is not

commensurate in scope with the claims and is therefore not persuasive. Claim 1 describes "said insert, o-ring or plug comprising ... scent...". Claim 1 fails to exclude the use of a tire wear indicator which is flush with the surface of the tread as in Great Britain 584. See page 3 lines 21-26 of Great Britain 584. Appellant has provided no convincing argument as to why such a rubber tread wear indicator does not have a scent during "use" of the tire. Great Britain 584's rubber wear indicator, like all rubber, inherently has a scent.

Great Britain 584 / 103 rejection

Appellant comments that the presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on (page 9 of Brief filed 3-7-08). Examiner comments that claim 1 describes "scent" and is not limited to "perfume or fragrance".

Appellant argues that Great Britain 584 fails to suggest an incorporated scent or fragrance. With respect to the 103 rejection, the secondary art to Korea, Japan 873 or German 356 suggest providing Great Britain 584's tread wear indicator with a scent.

Appellant argues that Korea's use of encapsulated fragrance as a wear indicator to be activated at the time the tire needs to be replaced does not make up the deficiencies of Great Britain 584. This argument is not persuasive. First: Claim 1 fails to require the tire to have the capability of release of the scent before the time the tire needs to be replaced. In particular, claim 1 fails to require fragrance compound and rubber compound at the tread surface of a new tire such that the scent is released when

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the tire is used for the first time. Second: Great Britain 584's wear indicator 10 is worn when "said tire is used for driving" and Korea motivates one of ordinary skill in the art to use smell (scent) to indicate wear of a tire.

Appellant argues that Japan 873 does not recite a plug, insert or o-ring. More properly, Great Britain 584 teaches a "removable insert" (wear indicator 10) as being part of the tire tread and Japan 873 (published 4-16-02) shows that a tire tread which releases a scent due to wear when the tire is used in a vehicle for driving was known in the tire art prior to applicant's filing date (4-10-04).

Appellant argues that German 356 fails to suggest that the smell can be emitted whenever the tire is exposed to normal use. This argument is not persuasive. First: Claim 1 fails to require that the scent be emitted whenever the tire is exposed to normal use. Second: Great Britain 584's wear indicator 10 is worn when "said tire is used for driving" and German 356 motivates one of ordinary skill in the art to use smell (scent) to indicate wear.

Japan 873 / 103 rejection

Appellant comments that the presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on (page 10 of Brief filed 3-7-08). Examiner comments that claim 1 describes "scent" and is not limited to "perfume or fragrance".

Appellant states: "Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire." (page 10 of Brief filed 3-7-08).

Examiner agrees that Japan 873 (published 4-16-02) shows that a tire tread which releases a scent due to wear when the tire is used in a vehicle for driving was known in the tire art prior to applicant's filing date (4-10-04).

Appellant argues that Japan 873 fails to teach a tire plug or insert. This argument is not persuasive because Japan 873 teaches a tire tread and motivates one of ordinary skill in the art to form the tire tread of French 013, Canada 958 or Japan 908 such that the tread emits an desirable aroma. It is noted that "removable insert" reads on (a) the replaceable tread as disclosed by French 013, (b) the replaceable tread of Canada 958 or (c) the member 6 of Japan 908. Appellant provides no convincing argument explaining why the replaceable tread of French 013 or Canada 958 is not an "insert". Also, appellant provides no convincing argument explaining why Japan 873's teaching to form a tread so as to emit aroma is not applicable to the replaceable tread of either French 013 or Canada 958 or Japan 908's tread containing member 6.

Appellant argues that there is no motivation to combine the references. Examiner disagrees. One of ordinary skill in the art would have been motivated to include perfume containing particles in the removable insert of French 013, Canada 958 or Japan 908 so as to obtain the expected benefits of (1) a tread which can emit desired aroma as the tire wears and (2) having part of the tread being removable to change color of the tread (French 013), having part of the tread replaceable to avoid the cost of replacing the entire tread (Canada 958) or improving the fashionableness of the tire (Japan 908). It is emphasized that each of the "removable inserts" of French 013,

Canada 958 and Japan 908 constitute part of the tread and Japan 873 suggests including perfume containing particles in the entire tire tread (all parts of the tread).

dependent claim 2 / Berliner

Appellant argues that Berliner's suggestion of adding pheromone to perfume does not make up for the deficiencies of the other references. This argument is not persuasive. It is undisputed that Japan 873 teaches a tire tread containing perfume and rubber. Berliner, which teaches perfuming products such as new cars (column 7), adds to Japan 873's disclosure of a tire for a car by suggesting the use of pheromone when using perfume.

dependent claims 4, 13 / French 340

Appellant's arguments regarding French 340 (pages 11 and 12 of Brief filed 3-7-08) are not persuasive since French 340 provides ample motivation (achieving visual monitoring of the degree of wear of the tire) to use a wear warning component in Japan 873's tire.

dependent claim 12 / Mellet et al

Appellant's arguments regarding Mellet et al (page 12 of Brief filed 3-7-08) are not persuasive since Mellet et al suggests using reflective particles for a tread cover of a tire so as to provide decoration.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Steven D. Maki/

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May 27, 2008

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